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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
09/926,062	11/19/2001	Reinhard Plaschka	PLAS3002/JEK	8599
23364	7590	10/06/2004	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/926,062	Applicant(s) PLASCHKA ET AL.	
	Examiner Mark T Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-14,16,17,19,21-23,27,29,31 and 36-41 is/are pending in the application.  
     4a) Of the above claim(s) 39-41 is/are withdrawn from consideration.  
 5) ☒ Claim(s) 1,3-5,27,31 and 36-38 is/are allowed.  
 6) ☒ Claim(s) 6-14,17,21,23 and 29 is/are rejected.  
 7) ☒ Claim(s) 16, 19, 22 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 3-14, 16, 17, 19, 21-23, 27, 29 have been amended for further examination. Claims 2, 15, 18, 20, 24-26, 28, 30 and 32-35 are canceled. Claims 36-41 have been added.

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***Election/Restriction***

2. Newly submitted claims 39-41 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 39-41 discloses a method for testing a document of value which was not previously examined.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 39-41 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Furthermore, a complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 11 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 11 recites the limitation "the surface" in line 3. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 19 recites the limitation "the visible spectral region" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-14, 17, 21, 23 and 29 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Stenzel (6,318,758).

Stenzel discloses in Fig. 1 and 2, a document of value, a foil, and printing ink comprising a security element of a cover foil (3) of a multilayer transfer material having at least one optically

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variable ink material (4, as stated in Col. 3, lines 5-10); and at least one machine readable feature substance (magnetic layer 5, as stated in Col. 3, lines 40-50) that is in the form of a code; a binder (adhesive layer 12, as stated in Col 6, lines 23-38) of conductive material; wherein the security element has two liquid crystals materials with different polarizations (Col. 5, lines 25-30); wherein the optically variable material is selected from the group of pigments (Col. 5, lines 25-30); wherein the machine readable feature substance is an IR-absorbent material (Col. 3, lines 1-4).

However, Stenzel does not disclose wherein the optically variable material and the feature substance are disposed in one layer; and wherein the optically variable material consist of a particle having suitable size and shape factor.

In regards to Claims **6 and 10**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the document having the optically variable material and feature substance in two separate layers, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Therefore, it would have been obvious to construct the document having separate layer of an optically variable layer and a machine readable feature substance, since applicant has not disclosed that having one layer is critical to the invention, and invention would function equally as well with a separate optically variable layer and a separate machine readable feature substance layer.

In regards to **Claim 17**, it would have been an obvious matter of design choice to make the different portions of the optically variable material particle of whatever shape or size was desired or expedient. A change in form or shape is generally recognized as being within the level

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of ordinary skill in the art, absent any showing of unexpected results. Therefore, it would have been obvious to construct the optically variable material particle of whatever form or size is desired by the end user, since applicant has not disclosed that a particular shape and size is critical to the invention, and invention would function equally as well with any particle shape or size.

***Allowable Subject Matter***

7. Claims 19/6, 19/10, 16, 22/6, and 22/10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 1, 3-5, 9/1, 14/1, 16/1, 17/1, 19/1, 21/1, 22/1, 27, 31 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record disclose multilayer transfer material and plastic pellets comprising optically variable material that conveys different color effects at different viewing angles and one machine readable feature substance that does not impair a visually visible optically variable effect of the optically variable material.

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***Response to Arguments***

10. Applicant's arguments filed on July 29, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the Stenzel reference does not disclose positioning "the optically variable layer and the feature substance in one layer", the examiner submits that it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the document having the optically variable material and feature substance in two separate layers, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Therefore, it would have been obvious to construct the document having separate layer of an optically variable layer and a machine readable feature substance, since applicant has not disclosed that having one layer is critical to the invention, and invention would function equally as well with a separate optically variable layer and a separate machine readable feature substance layer.




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***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

  
GREGORY VIDOVICH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

October 4, 2004